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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/655,484

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Takayuki Ogino

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74989

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ALPINE/BHGL

P.O. Box 10395

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EXAMINER

DURAN, ARTHUR D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/655,484	Applicant(s) OGINO ET AL.	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8-13,16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8-13,16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4, 8-13, 16, 18-20 are examined.

Response to Amendment

The Amendment filed on 10/1/2008 is insufficient to overcome the rejection.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/1/08 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method claim that fails to meet one of the above

requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 11-13 fail to meet the above requirements.

To correct this issue, the independent claim could be amended such that at least one feature of the body of the claims actively uses a technological apparatus (computer, network server, webpage, website, etc).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, 8-13, 16, and 18-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Tomita (20040054586) 365) in view of Mizuishi et al. (JP 2002230696 A -- 8/16/2002).
2. Regarding claims 1, 11, and 16, Wilkman teaches of a system and method “for providing transaction control for purchasing decisions that involve the use of credits, debits, loyalty points, affinity points, promotions, or currency transfers.” (Abstract). In particular, Wilkman teaches of obtaining user information (Fig. 5; [0102]-[0106]) and loyalty information related to the user ([0066]; [0110]). Thereafter, a query is done for merchants who satisfy various factors, one of which is number of loyalty points. ([0110];

[0113]). The system then displays merchant information and their related promotion for merchants that match the criteria (i.e. number of points). ([0116]-[0118]).

Wilkman further discloses that queries for services available related to user points can be made ([110,113]).

Wilkman does not explicitly disclose searching for only an available facility which offers a point service available to the user within said cumulative number of points.

However, Tomita discloses searching for only an available facility which offers a point service available to the user within said cumulative number of points ([215, 284]; claim 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Tomita's more searching for only facilities with services for available points to Wilkman's searching for facilities related to points. One would have been motivated to do this in order to provide facilities/services which are of interest to the user.

Additionally, Wilkman teaches of a system and method for a user being able to search for merchants that satisfy a certain requirement, such as loyalty points. (Wilkman, [0110]; [0113]). Wilkman teaches that a user can select a specific merchant/promotion in order to find further details related to that merchant/promotion. (Wilkman, [0118]). Furthermore, Wilkman explicitly teaches of a "map feature that presents the user with a map of the location of the service as well as other information." (Wilkman, [0129]). Additionally, Wilkman teaches that the system can be used on any portable device, such as a cell phone or personal digital assistant (PDA). Wilkman

further teaches of utilizing GPS and location information ([41, 128, 135]) and Wilkman discloses presenting map information, driving distance and travel time information from the user's current location to points of interest ([129]).

Wilkman does not explicitly teach of the system providing guidance by guiding a vehicle to the merchant.

However, given the above use of GPS, map information, driving distance, and travel time to a point of interest, it is obvious to one skilled in the art that Wilkman can provide routing or direction information. One would be motivated to do this because directions are an obvious extension of a map, driving distance, and travel time and further assist the user in arriving at the point of interest.

Alternatively, concerning the providing of directions, please see the rejection below further utilizing Smith.

Additionally, the prior art renders obvious:

“a driving state detector for detecting a driving state of the vehicle,
wherein said point managing section is adapted to combine at least two different types of points, including points acquired by the user through a point acquisition program and points acquired by the user according to the driving state detected by said driving state detector, so that points corresponding to the vehicle driving state detected by said driving state detector and points acquired through said point acquisition program are added to said cumulative number of points.”

The prior art renders obvious a point managing section that combines at least two different types of points, whereby points acquired by a user according to the driving

state of the user's vehicle are added together with different points acquired by the user through a point acquisition program.

Wilkman teaches of a system and method whereby a user enters in personal information, searches for a merchant/promotion based on various factors, is displayed a list of eligible merchants, and is given subsequent information related to merchant/promotion. (Wilkman, Abstract; [0110]; [0113]; [0118]; [0129]). Furthermore, Wilkman teaches that the system manages, tracks, and grants reward points. (Wilkman, [0110]; [0125]-[0126]).

Wilkman further discloses managing at least two different types of points ([135]).

Wilkman does not explicitly teach of awarding points to a user based on their driving activities. However, Mizuishi et al. teaches of a system and method for awarding points to a user based on characteristics of their actual driving. (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Wilkman's point management system with Mizuishi et al.'s teaching of awarding points based on driving. One would have been motivated to combine the references because Wilkman teaches of a method for managing points while Mizuishi et al. teaches of a method for obtaining points.

Hence, the Mizuishi reference discloses providing points for driving state or preferred driving state or preferred driving style (Mizuishi Abstract, also, see use of Mizuishi preceding).

And, the prior art also renders obvious that different types of points can be combined.

Wilkman discloses that different award types can be received by the user (Fig. 8; [135]) and Wilman discloses the structure such that different point types can be combined (Fig. 12). And, Wilkman discloses that points can be combined from across multiple or different award or point types:

“[0143] In one embodiment, the universal transaction manager acts as a unified billing system so that payments for established accounts may be executed either by manual configuration of the universal transaction manager by the user or automatically by the transaction manager as configured by the user's preferences. In one embodiment, the transaction manager may combine all the available opportunities including credit, debit, loyalty points and promotions to effect payment to a specified account. The unified billing system may also include an alert payment notification which could be executed from a variety of communication systems including email, telephone and paging for example.”

Hence, Wilman discloses combining different point and award types into a single type that can be used to effect a payment.

As a further example of this, Tomita discloses cumulating and converting different point types into a single point total (Figures 19b, 21a; 8b, 9f, 9g, 9h, 9i, 9j; and the below citations):

“[0176] The function of accumulating points includes a function of storing cumulative points, a function of calculating points, a function of determining an accumulation unit, and a function of converting the cumulative points.

[0196] As and when required by customers, customer's cumulative points may be moved from one store to another through a common center of the same group of stores. The customer's cumulative points may be converted into points of another group or store according to a predetermined rate. This results in commonly using different kinds of point services and improving service for customers.

[0235] Cumulative points may be converted into money, which is transferred to a customer's bank account. Cumulative points may be used as part or all of communication charges.

[0298] (41) The point accumulation comprises a section converting the points of a customer managed by a group of stores into points managed by another group of stores according to a predetermined rate if the customer requests the conversion."

Hence, the prior art renders obvious that different types of points can be combined.

Hence, the prior art renders obvious that points can be given for different activities, that points can be given for driving, that points from different activities or different types of points can be combined.

Hence, the prior art renders obvious the features of the Applicant's claims.

3. Regarding claims 2, 12, and 18, Wilkman teaches that the user can click on a promotion to find detailed information about the merchant, such as "driving distance,

travel time, photo of location, photo of building, sample menu, list of prices, dining ratings, and so forth.” ([0118]; [0129]).

4. Regarding claim 3-4, 13, 19-20, Wilkman teaches of storing promotion information related to merchants in a searchable database accessible to the user. ([0063], [0064]). Wilkman further teaches that the user can search and sort merchants and promotions based on the "number of loyalty points". ([0110], [0113]).

Claims 8-10: The prior art discloses the above. Wilkman does not explicitly teach of awarding points to a user based on their driving activities. However, Mizuishi et al. teaches of a system and method for awarding points to a user based on characteristics of their actual driving. (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Wilkman's point management system with Mizuishi et al.'s teaching of awarding points based on driving. One would have been motivated to combine the references because Wilkman teaches of a method for managing points while Mizuishi et al. teaches of a method for obtaining points.

5. Claims 1-4, 8-13, 16, and 18-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkman (US 2002/0013728 A1) in view of Tomita (20040054586) in view of Smith (US 6,314,365) in view of Mizuishi et al. (JP 2002230696 A -- 8/16/2002).

Regarding claims 1, 11, 16, please see the above.

Additionally, Wilkman teaches of a system and method for a user being able to search for merchants that satisfy a certain requirement, such as loyalty points.

(Wilkman, [0110]; [0113]). Wilkman teaches that a user can select a specific merchant/promotion in order to find further details related to that merchant/promotion.

(Wilkman, [0118]). Furthermore, Wilkman explicitly teaches of a “map feature that presents the user with a map of the location of the service as well as other information.”

(Wilkman, [0129]). Additionally, Wilkman teaches that the system can be used on any portable device, such as a cell phone or personal digital assistant (PDA). Wilkman further teaches of utilizing GPS and location information ([41, 128, 135]) and Wilkman discloses presenting map information, driving distance and travel time information from the user's current location to points of interest ([129]).

Wilkman does not explicitly teach of the system providing guidance by guiding a vehicle to the merchant.

However, given the above use of GPS, map information, driving distance, and travel time to a point of interest, it is obvious to one skilled in the art that Wilkman can provide routing or location information. One would be motivated to do this because directions are an obvious extension of a map, driving distance, and travel time and further assist the user in arriving at the point of interest.

As a further example of this, Smith teaches of a system and method for providing guidance to a vehicle using a users cell phone. (Smith, Abstract). In particular, Smith teaches that the user enters a destination into the cell phone (merchant destination) and the cell phone provides directions and a map to the user in a vehicle. (Smith, Fig. 1; Col 1, Lines 65-67; Col 2, Lines 1-61). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Wilkman's teaching

of a system on a cell phone for providing merchant information (including a map) based on a user's query with Smith's teaching of a cell phone that is used to navigate a vehicle to a desired location. One would have been motivated to do so because a navigational system is a known upgrade to a map based directional system.

Also, in regards to the other features please see the rejection of the claims above utilizing Wilkman in view of Tomita in view of Mizuishi

Regarding claims 2-4, 8-10, 12-13, and 18-20, please see the rejection above.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are not found persuasive.

In the claim amendments dated 10/1/08, Applicant has moved the features of dependent claim 7 into the independent claims. Applicant has also clarified the language of the features that were formerly in claim 7, now in the independent claims.

These features were added to the independent claims:

“a driving state detector for detecting a driving state of the vehicle,
wherein said point managing section is adapted to combine at least two different types of points, including points acquired by the user through a point acquisition program and points acquired by the user according to the driving state detected by said driving state detector, so that points corresponding to the vehicle driving state detected by said driving state detector and points acquired through said point acquisition program are added to said cumulative number of points.”

Also, on page 8 of Applicant's Remarks dated 10/1/08, Applicant states, "Applicants submit that there is no disclosure in this passage -- or anywhere else in Wilkman -- that describes or suggests a point managing section that combines at least two different types of points, whereby points acquired by a user according to the driving state of the user's vehicle are added together with different points acquired by the user through a point acquisition program."

However, the Mizuishi reference discloses providing points for driving state or preferred driving state or preferred driving style (Mizuishi Abstract, also, see use of Mizuishi in the rejection above).

And, the prior art renders obvious that different types of points can be combined.

Wilkman discloses that different award types can be received by the user (Fig. 8; [135]) and Wilman discloses the structure such that different point types can be combined (Fig. 12). And, Wilkman discloses that points can be combined from across multiple or different award or point types:

"[0143] In one embodiment, the universal transaction manager acts as a unified billing system so that payments for established accounts may be executed either by manual configuration of the universal transaction manager by the user or automatically by the transaction manager as configured by the user's preferences. In one embodiment, the transaction manager may combine all the available opportunities including credit, debit, loyalty points and promotions to effect payment to a specified account. The unified billing system may also include an alert payment notification which could be executed

from a variety of communication systems including email, telephone and paging for example.”

Hence, Wilman discloses combining different point and award types into a single type that can be used to effect a payment.

As a further example of this, Tomita discloses cumulating and converting different point types into a single point total ([176, 196, 235, 298]; Figures 19n, 21a; 8b, 9f, 9g, 9h, 9i, 9j):

“[0176] The function of accumulating points includes a function of storing cumulative points, a function of calculating points, a function of determining an accumulation unit, and a function of converting the cumulative points.

[0196] As and when required by customers, customer's cumulative points may be moved from one store to another through a common center of the same group of stores. The customer's cumulative points may be converted into points of another group or store according to a predetermined rate. This results in commonly using different kinds of point services and improving service for customers.

[0235] Cumulative points may be converted into money, which is transferred to a customer's bank account. Cumulative points may be used as part or all of communication charges.

[0298] (41) The point accumulation comprises a section converting the points of a customer managed by a group of stores into points managed by another group of stores according to a predetermined rate if the customer requests the

conversion."

Hence, the prior art renders obvious that different types of points can be combined.

Hence, the prior art renders obvious that points can be given for different activities, that points can be given for driving, that points from different activities or different types of points can be combined.

Hence, the prior art renders obvious the features of the Applicant's claims.

Also, in regards to the propriety of the Final Rejection dated 7/16/2008, this was addressed on page 8 of the action dated 7/16/2008.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Yoshioka (20020004730) discloses searching for services related to cumulative points available ([33]); b) Sato (20030128391) discloses searching for services related to cumulative points available ([48]).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner
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10/30/08